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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,056	03/19/2004	Toshio Tanaka	119131	7066
25944 7590 12/27/2006 OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER DUNHAM, JASON B	
			ART UNIT 3625	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/804,056	<b>Applicant(s)</b> TANAKA ET AL.	
	<b>Examiner</b> Jason B. Dunham	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/19/04, 7/22/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Applicant is advised that should claim 6 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 13 is rejected under 35 U.S.C. 101.**

Referring to claim 13. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer

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component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claim 13 fails to recite a computer program that is embodied on a computer-readable medium. The claim is merely directed to a computer program per se.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5 and 8-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Weitzman (U.S. Patent Application Publication No. 2003/0182210).**

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Referring to claim 1. Weitzman disclose a layout system with order placement capability for performing layout, comprising:

- Layout section for performing layout (Weitzman: abstract); and
- Layout order placing section for placing an order for layout on the basis of a layout result produced by said layout section (Weitzman: paragraph 9).

Referring to claim 2. Weitzman further discloses a layout system with order placement capability comprising user operation input section for inputting user operations, wherein said layout section performs layout according to operations inputted through user operation input section (Weitzman: figure 4).

Referring to claim 3. Weitzman further discloses a layout system with order placement capability wherein said layout order placing section for generating order data including a layout result produced by said layout section and sending said generated order data to a vendor together with an order request (Weitzman: abstract, figure 4, and paragraph 9).

Referring to claim 4. Weitzman further discloses a layout system with order placement capability wherein said layout order placing section generates order data including an operation log information from which operations input through said user operation input section can be retraced with a layout result produced by said layout section and sending said data to a vendor together with an order request (Weitzman: paragraphs 59-61). The examiner notes that Weitzman discloses outputting user input information for placing an order.

Referring to claim 5. Weitzman further discloses a layout system with order placement capability wherein said layout order placing section generates order data including an operation log information indicating the log of operations through said user operation input section and the layout result produced by said layout section and sending said generated order data to a vendor together with an order request (Weitzman: paragraphs 59-61).

Referring to claim 8. Weitzman further discloses a layout system with order placement capability comprising layout evaluating section for evaluating a layout result produced by said layout section (Weitzman: figure 5a and paragraph 53).

Referring to claim 9. Weitzman further discloses a layout system with order placement capability wherein:

- Said layout evaluating section evaluates a layout result produced by said layout section and, depending on the result of the evaluation, requests said layout order placing section to place an order for layout (Weitzman: paragraphs 57-58); and
- Said layout placing section places an order for layout on the basis of a layout result produced by said layout section if said layout order placing section is requested to place an order for layout (Weitzman: paragraphs 22 and 57-58).

Referring to claim 10. Weitzman further discloses a layout system with order placement capability wherein an order condition can be set in said layout system and said layout evaluating section evaluate a layout result produced by said layout section and, if the result of the evaluation meets said order condition, requests said layout order placing section to place an order for layout (Weitzman: paragraphs 37-39).

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Referring to claim 11. Weitzman further discloses a layout system with order placement capability wherein said layout evaluating section presents said evaluation result to a user and, if placement of an order for layout is approved by said user, requests said layout order placing section to place said order for layout (Weitzman: paragraphs 53 and 57-58).

Referring to claim 12. Weitzman further discloses a layout system with order placement capability wherein said layout placing section places an order for layout on the basis of a layout result produced by said layout section by using one of a plurality of ordering system that is specified by the user (Weitzman: paragraph 22).

Referring to claims 13-14. Claims 13-14 are rejected under the same rationale set forth above as Weitzman discloses programs embodied in mediums and methods according to claims 13-14 (Weitzman: abstract and paragraph 62).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weitzman (U.S. Patent Application Publication No. 2003/0182210) in view of Gage (U.S. Patent No. 6,741,904).**

Referring to claim 6-7. Weitzman discloses all of the above as noted under the 102(e) rejection but does not expressly disclose a system wherein said layout system is communicably connected to a matching system that performs matching with a designer. Gage discloses a layout system with order placement capability wherein said layout system is communicably connected to a matching system that performs matching with a designer and said layout order placing section generates order data including a layout result produced by said layout section and sends said generated order data to said matching system together with an order request (Gage: abstract, figure 1, column 3, line 66 – column 4, line 21). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the system of Weitzman to have included a matching system that performs matching with a designer, as taught by Gage, for facilitating the selection of designers (Gage: abstract). Claim 7 is rejected under the same rationale set forth above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBD  
Patent Examiner  
12/18/06



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